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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,236	09/17/2003	Sandra M. Maclean	11842/US/2	5239
25763 7590 09/17/2008 DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT SUITE 1500 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498				
EXAMINER ANDERSON, CATHARINE L				
ART UNIT		PAPER NUMBER		
3761				
MAIL DATE		DELIVERY MODE		
09/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/664,236

Applicant(s)

MACLEAN ET AL.

Examiner

Lynne Anderson

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 10-31 and 35-42 is/are pending in the application.
- 4a) Of the above claim(s) 10-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 25-31 and 35-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 17 June 2008 have been fully considered but they are not persuasive.
2. In response to the applicant's argument that the limitation "wherein the bottom layer protects the surface from bodily fluids that soak through the top layer" is supported by paragraph 51 of the present specification, it is noted that this limitation still constitutes new matter. The present specification discloses that the bed-liner helps reduce worries about fluid soaked bedding, but does not explicitly teach that this is due to the bottom layer protecting the bedding from fluid that has soaked through the top layer. Since there is no specific disclosure of the claimed limitation in the present specification, the limitation is new matter.
3. In response to the applicant's argument that polypropylene may be impermeable and would be understood by one skilled in the art to be impermeable, it is noted that what would be obvious to one skilled in the art is not at issue. The issue of new matter is raised when the present specification lacks an explicit teaching of the claimed limitations. Since the present specification does not teach the polypropylene bottom layer is fluid impermeable, the claimed limitation is new matter.
4. In response to the applicant's argument that one skilled in the art would recognize the difference between a disposable towel and a bed-liner, it is noted that the disposable towel is fully capable of functioning as a bed-liner, and therefore fulfills the claimed limitation.

5. In response to applicant's argument that the scoop of Schumacher cannot be construed as a specimen pan, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The scoop of Schumacher is sized and shaped such that material such as human tissue can be received therein.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the size of the container) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. In response to the applicant's argument that Schumacher is not pertinent prior art, it is noted that both Schumacher and the present invention pertain to kits for cleaning up bodily waste, and therefore fall into the same field of invention.

Response to Amendment

8. The Declaration under 37 CFR 1.132 filed 17 June 2008 is insufficient to overcome the rejection of claims 1 and 25-31 based upon 35 U.S.C. 102(b) as set forth in the last Office action because: The recited state law does not overcome the legal aspects of the rejection of the present claims. The present claims cannot be interpreted

in view of the requirements of the recited state law regarding the disposal of remains after a miscarriage.

9. The amendment filed 17 June 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The pad having a bottom layer that protects the surface from bodily fluids that soak through the top layer is not supported in the present specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Specification

10. The amendment filed 17 June 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The pad having a bottom layer that protects the surface from bodily fluids that soak through the top layer is not supported in the present specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1, 25-31, 35-37, and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The pad having a bottom layer protects the surface from bodily fluids that soak through the top layer or is impermeable is not supported in the present specification. The present specification to not explicitly teach the pad having a bottom layer formed of an impermeable material, or the bottom layer providing protection against fluid that has soaked through the top layer. Therefore, these limitations are considered to be new matter.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1 and 25-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schumacher (4,917,238).

15. With respect to claims 1 and 31, assuming the limitation "miscarriage" is given little patentable weight, Schumacher discloses a kit 10 for cleaning up body waste such as vomit, blood, feces and the like (column 1, lines 9-12; column 2, lines 6-7; figure 1) comprising a pad 52 having an absorbent surface (column 2, lines 45-47); a disposable absorbent towel 50 and sanitary napkin 51 (column 2, lines 45-47); disposable plastic

gloves 57, 58 (column 2, lines 52-53); scoop/specimen pan 80; and container 64. The specimen pan 80 is fully capable of receiving human tissue, and the container 64 is fully capable of holding fetal remains.

16. Alternatively, assuming the limitation "miscarriage kit" is given patentable weight and is consistent with its plain ordinary meaning of expulsion of a fetus from the womb before it is able to survive independently (see Oxford online dictionary), regarding claim 1 Schumacher discloses a waste cleanup kit 10 for cleaning up body waste such as vomit, blood, feces and the like (column 1, lines 9-12; column 2, lines 6-7; figure 1) that is thus capable of being used as a miscarriage kit since the elements of the kit are fully capable of being used to clean up after a miscarriage.

17. With respect to claim 25, the container 64 is spill-proof and sanitary since it has a cap 68 that confines the liquids (column 3, line 20).

18. With respect to claims 26-30, the kit further comprises label/list 63 (column 2, lines 64-68); two plastic bags 53, 54 (column 4, lines 47-48); germicidal hand wipe 7; and scraper 90 (column 3, lines 25 and 33-34).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher (4,917,238) in view of Gordon (6,434,762).

21. Schumacher discloses a kit with a specimen pan 80 as disclosed above with respect to claim 1. Schumacher *does not expressly disclose* the pan is configured to fit inside the rim of a toilet. Gordon discloses a stool/waste collecting apparatus 10 secured to a toilet seat (column 2, lines 28-31) and having a receptacle/specimen pan 14 which fits inside the rim of a toilet (column 2, lines 46-55; figures 1-3) for depositing bodily waste without fear of touching the sample (column 3, lines 31-41). One would be motivated to modify the kit of Schumacher with the specimen pad of Gordon to improve the anti-contamination of the system since both references disclose apparatus to dispose of bodily waste. Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to modify the kit, thus providing a specimen pan to fit inside a toilet rim.

22. With respect to the container being opaque, Schumacher further discloses a container 12, as shown in figure 2, formed from cardboard, as described in column 2, lines 8-9. Cardboard is an opaque material, and therefore Schumacher discloses a container that is opaque.

23. With respect to claims 36-37, the measurement guide is considered to be printed matter, which does not distinguish over the prior art when no new and unobvious functional relationship exists between the substrate and the printed matter (see MPEP 2112.01, III).

24. Claims 38-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher (4,917,238) in view of Gallo et al. (6,622,856).

25. Schumacher discloses all aspects of the claimed invention with the exception of a thermometer. Gallo teaches a medical kit including a thermometer, as disclosed in column 5, line 25, for the monitoring of temperature. It would therefore be obvious to one of ordinary skill in the art at the time of invention to provide the kit of Schumacher with a thermometer, as taught by Gallo, for the monitoring of temperature.

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynne Anderson whose telephone number is (571)272-4932. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. A./
Examiner, Art Unit 3761
/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761